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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Hiroshi KOJIMA

Group Art Unit: 1771

Application No.: 10/519,796

Examiner: A. SPERTY

Filed: December 29, 2004

Docket No.: 123745

For: ELECTROMAGNETIC SHIELDING SHEET AND METHOD OF FABRICATING
THE SAME

RESPONSE TO LACK OF UNITY OF INVENTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the August 9, 2006, Lack of Unity of Invention Requirement, please consider the following.

In the Lack of Unity of Invention Requirement mailed August 8, 2006, restriction was required between Groups I-II.

In response to the Requirement, Applicants hereby elect Group I, claims 1-8. This election is made with traverse, for the following reasons.

Applicants respectfully assert that the Requirement is improper under the rules of practice in PCT National Phase applications, because the appropriate unity of invention standards have not been properly applied by the Patent Office. In PCT National Phase applications, the Examiner may issue a restriction-type Requirement if no unity of invention exists. However, the Examiner must state why there is no "single general inventive concept." See MPEP §1893.03(d). Therefore, a single application may include one invention, or more

than one invention if the inventions are "linked as to form a single general inventive concept." Id. (emphasis added). If multiple inventions are included in the application, they are deemed to be linked if there exists a "technical relationship among the inventions that involves at least one common or corresponding special technical feature." Id.

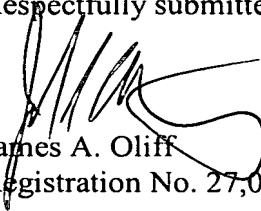
The Office Action asserts that unity of invention does not exist, because the groups of claims do not share the same special technical features of a metal mesh, coated with Cu-Co alloy particles, formed by etching. Applicants respectfully disagree.

In the present application, the special technical feature which is common between the groups of claims is the electromagnetic shielding sheet of claim 1. This electromagnetic shielding sheet of claim 1 includes a mesh metal layer and a blackened layer formed on one surface of the metal mesh layer. See claim 1. The blackened layer can be formed of Cu-Co alloy particles. See claim 2. This structure forms the product of Group I (claims 1-8), and is formed in the method of Group II (claims 9-10). Under the PCT rules of practice, unity of invention exists because this special technical feature is common to all three groups of claims, and therefore a Restriction Requirement is improper. The step of etching, recited in claim 9, is merely a method step used in making the product. The Examiner's attention is also directed to Annex B, Part 2, of the PCT Administrative Instructions (MPEP Appendix AI) wherein unity of invention is demonstrated between a method of making Compound X, Compound X, and a method of using Compound X. (Example 1). This Example further demonstrate that Groups I and II posses unity of invention and should not be subject to a Restriction Requirement.

Because the Examiner has not properly demonstrated an absence of unity of invention under the rules, the Restriction Requirement is improper. Reconsideration and withdrawal of the Restriction Requirement are respectfully solicited.

Should the Examiner have any questions regarding this response or the application in general, he is invited to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,


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JAO:JSA

Date: September 8, 2006

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